



REQUEST FOR PRE-APPEAL REVIEW

In the application claims 7-10 and 13-27 remain pending. Claims 1-6, 11, and 12 have been canceled without prejudice.

The pending claims presently stand rejected under 35 U.S.C. § 103 as being rendered obvious by Daum (U.S. 2003/0046377) as further modified by one or more of Allport (U.S. 6,104,334), Ketcham (U.S. 6,195,589), Kolawa (U.S. 6,236,974), and Amro (U.S. 6,507,762).

The reconsideration of the rejection of the claims is respectfully requested.

As concerns the rejection of the claims under 35 U.S.C. § 103, it is respectfully submitted that, to establish a *prima facie* case of obviousness, all of the claim elements must be expressly or inherently described in the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). To be “inherently” described in a prior art reference the reference “must make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill.” Inherency “may not be established by probabilities or possibilities.” The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Continental Can Co. USA v. Monsanto Co.*, 948 F.3d 1264 (Fed. Cir. 1991).

Considering now Daum, it has been acknowledged in the Office Action that Daum fails to expressly disclose the claimed uploading of data that functions to identify the consumer appliance from the hand-held device to a system located remotely from the consumer appliance and using the data that functions to identify the consumer appliance at the remote system to retrieve an electronic document comprising human-readable information in a form for instructing a consumer how to interact with one or more controls of the consumer appliance for the purpose of operating the consumer appliance. Rather, the rejection of the claims is based upon the allegedly “inherent” disclosure of these claim elements within Daum. More particularly, it has

been alleged that, “inherently, in order to receive *diagnostic routines* from remote systems 140, 150, where *diagnostic information*¹ stored by appliance type and serial number, the appliance identification information must be uploaded to remote systems 140, 150.” (Office Action on pages 11-12, emphasis added).

In response to this assertion that the claimed subject matter is “inherently” disclosed within Daum, it is respectfully submitted that even the misquoted language from Daum acknowledges that Daum **does not** expressly set forth that the downloadable “*routines*” are stored by appliance type and serial number. Rather, in keeping with the misquotation, Daum expressly describes that it is appliance *diagnosis information* that is stored by appliance type and serial number. Therefore, since Daum **fails to ever** expressly set forth that appliance *diagnostic routines* are stored by appliance type and serial number, it is respectfully submitted that Daum fails to even provide the foundation upon which the conclusion of “inherency” may be built.

Considering Daum further, it is also noted that Daum **never** uses the terms “diagnosis information” and “diagnostic routines” interchangeably as is done in the rejection of the claims. Accordingly, it is respectfully submitted that it cannot be definitively said that Daum intended the term “diagnostic routine” to be included within the term “diagnosis information” such that the “diagnostic routines” of Daum would also be stored by appliance type and serial number. Instead, a common definition of “diagnosis” precludes any such conclusion from being definitive, i.e., the Daum “diagnosis information” may be nothing more than stored information for an appliance identified by its type and serial number which information was obtained as a result of a diagnostic being executed on that appliance. (See Merriam-Webster Online Dictionary).

¹ Daum uses the term “*diagnosis information*” in para. 0021 and not the term “diagnostic information” as quoted by the Examiner.

Since Daum **never** sets forth that the “*diagnostic routines*” are stored by appliance type and serial number, it simply cannot be inferred that the “*diagnostic routines*” are **required** to be identified by uploaded appliance type and serial number data as is asserted as the basis for the rejection. Rather than “inherently” disclose that which has be asserted within the Office Action, it is respectfully submitted that it is possible that the Daum *diagnostic routines* are generic routines that may be uniformly used by the diagnostic interface (110) and, therefore, would not need to be separately identified by appliance type or model number. Furthermore, it is equally possible that the Daum diagnostic routines, even if stored by appliance type and appliance model number, are all downloaded into the diagnostic interface (110) in a single download transaction and, therefore, there would never be a need to upload any identifying information to thereby retrieve the same. Nothing from within Daum precludes these possibilities. As such, it cannot be inferred that within Daum there is a requirement that an appliance type and serial number be uploaded to thereby cause the downloading of a *diagnostic routine* from the remote server (140). (Para. 0025). Accordingly, since there is no evidence that the *diagnostic routines* of Daum are stored by appliance type and serial number and there is no evidence that particular or selected diagnostic routines are downloaded to the diagnostic interface (110), i.e., diagnostic routines that would be first identified by uploaded appliance type and model data, it cannot be said that Daum makes clear that the missing descriptive matter of uploading and using at the remote server (140) appliance identification information to download *diagnostic routines* is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill in the art as is required of “inherency.”

It is similarly respectfully submitted that, as concerns the *diagnosis information* that is stored at the remote service center (140) of Daum by appliance type and serial number, **nowhere**

does Daum disclose that this *diagnosis information* is downloadable to the diagnostic interface (110) of Daum. Similarly, **nowhere** does Duam disclose, teach, or suggest that the *diagnosis information* is used for any purpose by the diagnostic interface (110), let alone to retrieve programs, diagnostic routines, upgrade messages, or the like as seems to be asserted in the Advisory Action. Accordingly, since it cannot be said that the *diagnosis information* of Daum is necessarily downloadable to the diagnostic interface (110) or used for any purpose by the diagnostic interface (110), it likewise cannot be said that Daum makes clear that the missing descriptive matter of uploading and using at the remote server (140) appliance identification information to download *diagnosis information* is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill in the art as is required of “inherency.”

From the foregoing it will be appreciated that Daum cannot be said to disclose, teach, or suggest, either expressly (as acknowledged) or inherently (as demonstrated), those claim elements relied upon in the rejection of the claims. More specifically, it is respectfully submitted that nothing from within Daum can be said to **make clear** that Daum includes the claimed elements of uploading data that functions to identify a consumer appliance from the hand-held device to a server located remotely from the consumer appliance where the server uses the data to retrieve an electronic document comprising human-readable information in a form for instructing a consumer how to interact with one or more controls of the consumer appliance for the purpose of operating the consumer appliance. Therefore, since Daum fails to disclose, teach, or suggest these claimed elements of the invention, and nothing from any of Allport, Ketcham, Kolawa, or Amro can be said to suggest modifying Daum to include these claimed elements of

the invention, it is respectfully submitted the rejection of the claims fails to present a *prima facie* case of obviousness under 35 U.S.C. § 103 and must be withdrawn.

Conclusion

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the reviewing panel is respectfully requested.

Date: May 2, 2006

By:

Respectfully Submitted;



Gary R. Jarosik
Reg. No. 35,906
Greenberg Traurig, LLP
77 W. Wacker Drive, Suite 2500
Chicago, Illinois 60601
(312) 456-8449